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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,015	04/22/2005	Bernhard Banowski	HM/5.22840/A/HEK 2/PCT	8747

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CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
540 WHITE PLAINS RD  
P O BOX 2005  
TARRYTOWN, NY 10591-9005

EXAMINER
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KIM, VICKIE Y

ART UNIT	PAPER NUMBER
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1618

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/511,015

Applicant(s)

BANOWSKI ET AL.

Examiner

Vickie Kim

Art Unit

1618

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 6 and 9-11.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).  
13. ☒ Other: PTO-892 attached.

**VICKIE KIM  
PRIMARY EXAMINER**

Vickie Kim  
Primary Examiner  
Art Unit: 1618

Continuation of 11. does NOT place the application in condition for allowance because: applicant's argument is not persuasive for the reasons set forth in final office action. The claims 6, 9-11 are drawn to a method of inhibiting arylsulfatase activity by applying an effective amount of hydroxydiphenyl ethers of formula I used as a deodorant or antiperspirant composition. Holzl(US'836) teaches same hydroxydiphenyl ether compounds used as a deodorant or antiperspirant via antimicrobial activity against staphylococcus epidermis or corynebacterium bacterias(e.g. xerosis or minutissimum, see page 29, table 1 and page 9, deodorant composition example at paragraph 173-177. The missing information from Holzl's teaching is part of underlying mechanism responsible for the said deodorant activity. At that time of the invention was filed, the state of the art recognizes and acknowledges that axillary odorants are androgen steroids (e.g. 5-alpha-androstenol and 5-alpha-androstenon), see also applicant's own disclosure at page 1, second paragraph as well as other numerous documents such as Eigen(US'559), Gower(1997), US4170638, Eigen(1990, J. cosm. chemists), WO'01/99376, see PTO-892), As well as applicant's own disclosure(at page 1), the state of art(see all the documents above) also recognizes that arylsulfatase is responsible for break down (hydrolysis) of said odorants and said arylsulfatase is bacterial exoenzymes where coryneform bacteria and staphylococcus epidermidis possess arylsulfatase activity(see Eigen(US'559, column 2, lines 15-30), and Gower(1997):abstract, US4170638, etc). Having said that( having known these), one skilled artisan would have readily envisaged the claimed invention(i.e. an inhibition of arylsulfatase by hydroxydiphenyl ether compounds and its use as deodorant or antiperspirant) as underlying mechanism for patented invention(Holzl's patented invention (i.e. a method of utilizing hydroxydiphenyl ether compounds as deodorant or antiperspirant via antimicrobial activity against corynebacteriums and staphylococcus epidermis(see above for detailed teaching). Especially, an effective amount of active ingredients required according to the instant invention for the inhibiting arylsulfatase activity is overlapping with Holzl's teaching(see instant invention: present in about 0.001-2%, preferably 0.01-0.5% in light of specification(see page 12) whereas Holzl also uses 0.01-5% of hydroxydiphenylether compounds in deodorant composition(see paragraph 173-177 at page 9) to reduce the body odour). the conclusion is readily apparent to any skilled artisan when Holzl's teaching is learned in view of the general knowledge available at that time of the invention as filed, wherein said conclusion is that the inhibition of arylsulfatase can be achieved by administration of hydroxydiphenyl ether compounds via their antimicrobial activity of microorganisms(e.g. coryneform or staphylococcus bacteris) which are responsible for arylsulfatase activity, especially with same amount of active agent being used. MPEP (2112) clearly states:

**SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY**

"[T]he discovery of a previously unappreciated property of a prior art composition or a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas powder co. v. Ireco Inc., 190 F 3d 1342, 51 USPQ2d 1943, 1947(Fed. Cir. 1999). Thus the claiming of a new use, new functioning or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F 2d 1252, 1254, 195 USPQ430, 433 (CCPA 1977). See also MPEP 2112.01 with regard to inherency.

For the reasons above, the rejection set forth in final office action is maintained.